



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,953	02/01/2001	Hiroshi Ono	P/647-137	9136

2352 7590 02/12/2004

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 100368403

EXAMINER

NGUYEN, DUC M

ART UNIT PAPER NUMBER

2685

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,953

Applicant(s)

ONO, HIROSHI

Examiner

Duc M. Nguyen

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-10 and 12-15 is/are rejected.
- 7) ☐ Claim(s) 4, 5 and 11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2, 4, 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

1. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 6 recites the limitation of requesting/receiving content directly from the Internet to the external server, this would remove the limitation of "transferring the content acquisition from the radio terminal to the external server" as recited in claim 1. Accordingly, claim 6 has not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2685

2. Claims 1-11, 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 1, 4-5, 7, 9, the claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim 14 recites the limitation "said terminal" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim because it is not clear which terminal, external terminal or radio terminal (recited in claim 12), would be served as the antecedent basis for the recited "said terminal".

Accordingly, the following changes should be made,

As to claim 1, "a self device" should be changed to "the radio terminal itself".

As to claims 2-6, 8, "A terminal" should be changed to "The radio terminal" in line 1 of the claims.

As to claim 4, insert "radio" preceding "terminal" in line 2 of the claim, and

- "the self device" should be changed to "the radio terminal itself" in line 4-5 of the claim, and
- "the self device" should be changed to "itself" in line 8 of the claim.

As to claim 5, "the self device" should be changed to "itself" in line 7 of the claim.

As to claim 7, "a self device" should be changed to "itself" in line 9 of the claim.

As to claim 9, "a self device" should be changed to "the radio terminal itself" in line 12 of the claim.

Art Unit: 2685

As to claims 10-11, "A system" should be changed to "The system" in line 1 of the claims.

As to claims 13-15, "A terminal" should be changed to "The external terminal" in line 1 of the claims.

As to claim 14, insert "external" preceding "terminal" in line 2 of the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims **1-3, 7-10, 12-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Metso** et al (US **5,920,826**).

Regarding claim **7**, **Metso** discloses a radio terminal capable of receiving text message data such as e-mail, fax from different networks (see Figs. 1-2 and col. 3, lines 50-60). Here, since the radio terminal comprises memories such as ROM, RAM for storing receiving data, a control circuitry for controlling the demodulation and converting the data for outputting to either the display or the speaker, it is clear that with the broadest reasonable interpretation, the radio terminal would comprise the conversion means (i.e, converting RF signals to baseband signals, then to audio data or display data) and the content reconstruction means (i.e, reconstruct audio data for outputting

voice to a speaker, or reconstruct graphic data for displaying on the screen of the display) as claimed. Although Metso fails to disclose the data is acquired from the Internet network, such Internet acquisition is well known in the art. Therefore, it would have been obvious to one skill in the art to modify Metso for downloading information from Internet as well, to provide a radio terminal as claimed, for utilizing advantages of the Internet network such as low cost, global information available in real-time.

Regarding claim 8, it is rejected for the same reason as set forth in claim 7 above. In addition, the memory or buffers for storing display data or audio data would read on the "second content storage means" as claimed.

Regarding claim 12, it is rejected for the same reason as set forth in claim 7 above. In addition, **Metso** discloses an external computer terminal capable of transferring data to/from the radio terminal (see Fig. 4 and col. 3, lines 13-23 and col. 7, lines 24-50). Here, as mentioned by Metso, the external computer terminal has more memory than the radio terminal and that data messages can be stored and archived in the computer terminal. Therefore, when a user receives a message and transfer the message to the computer for storage, this would read on the "content reception means" as claimed. Further, when a user request for receiving a data message stored at the computer, the computer would retrieve the data from the memory and converting to the message format (i.e, graphic, text, etc) for transferring to the radio terminal, this would read on the "content conversion means" and "content transmission means" as claimed.

Regarding claim 13, it is rejected for the same reason as set forth in claim 12 above. In addition, it would have been obvious for reconstructing un-encrypted data

messages without doing any conversion.

Regarding claim **14**, it is rejected for the same reason as set forth in claim 12 above. In addition, it would have been obvious that when the computer retrieves data from the memory and converting the data to the message format (i.e, graphic or text) for transferring to the radio terminal for display, the conversion would be done based on the reconstruction capability of the radio terminal (i.e, memory capability or display capability) to prevent memory overflow errors, this would read on the "content conversion means" and "content transmission means" as claimed.

Regarding claim **15**, it is rejected for the same reason as set forth in claim 12 above. In addition, it is clear that that the data would be received in response the request of data acquisition from the user.

Regarding claims **1, 9**, the claims are interpreted and rejected for the same reason as set forth in claim 14 above.

Regarding claim **2**, it is rejected for the same reason as set forth in claim 1 above. In addition, Metso disclose a radio communication and a cable communication as claimed (see Figs. 4-5).

Regarding claim **3**, it is rejected for the same reason as set forth in claim 1 above. In addition, it would have been obvious for reconstructing a data message without doing any conversion (i.e, un-encrypted data).

Regarding claim **10**, it is rejected for the same reason as set forth in claim 9 above. In addition, with the broadest reasonable interpretation, the control circuitry MCU of the radio terminal in Metso's reference would read on the "internal server" as claimed.

Allowable Subject Matter

4. Claims 4-5, 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

As to claims 4-5, 11, the cited prior art of record fails to disclose or made it obvious an apparatus or method for acquiring contents from the Internet which comprises components and steps as specified in the claims, wherein a determination means is utilized as recited in claim 4, or a partial reconstruction of the content being transferred to the external server as recited in claim 5, or the request and acquisition of the content are performed by the external server via the radio terminal as recited in claim 11.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Inoue et al (US Pat No. 6,170,057), Mobile computer and method of packet encryption and authentication in mobile computing based on security policy of visited network.

Rager et al (US Pat No. 5,412,721), Method for loading and utilizing a key in a secure transmission device.

Hayashi (US Pat No. 6,192,259), Portable radio apparatus having function for compressing and transmitting data.

Yu et al (US Pat No. 6,271,865), Cellular phone handset which can display special characters.

Sashihara (US Pat No. 6,434,405), Transmitting and receiving card selectively attached to portable phone or information terminal.

Eichinger et al (US Pat No. 6,370,374), Personal chip card for a mobile radio terminal.

McGregor et al (US Pat No. 6,138,004), Secure interlink receiver for remote programming of wireless telephones.

2. **Any response to this action should be mailed to:**

Commissioner of Patent and Trademarks

Washington, D.C. 20231

or faxed to:

703-872-9314 (for formal communications intended for entry)

(for informal or draft communications, please label PROPOSED or DRAFT)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc M. Nguyen whose telephone number is 703-306-

Art Unit: 2685

4531. The examiner can normally be reached on Monday-Thursday (9:30 AM – 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on 703-305-4385. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Duc M. Nguyen
Feb 4, 2004

A handwritten signature in black ink, appearing to read 'Duc M. Nguyen', written over the typed name and date.